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UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

SUMMONS IN A CIVIL ACTION

ELF ATOCHEM NORTH AMERICA, INC.

v.

Q. Todd DICKINSON

CASE NUMBER 1:99CV02559

CAS

JUDGE: Thomas Penfield Jackson

DECK TYPE: Civil General

DATE STAMP: 09/27/1999

TO: (Name & Address of Defendant)

Q. Todd DICKINSON
Acting Commissioner of the
United States Patent and Trademark Office
Washington, DC 20231

YOU ARE HEREBY SUMMONED and required to serve upon PLAINTIFF'S ATTORNEY (name and address)

Herbert H. Mintz
Richard B. Racine
Michael R. McGurk
FINNEGAN, HENDERSON, FARABOW,
GARRET & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, DC 20005

an answer to the complaint which is herewith served upon you, within 60 days after service of this summons upon you, exclusive of the day of service. If you fail to do so, judgment by default will be taken against you for the relief demanded in the complaint. You must also file your answer with the Clerk of this Court within a reasonable period of time after service.

NANCY MAYED-WINTINGTON
CLERK

SEP 27 1999
DATE

Nancy Mayed-Wintington
(BY) DEPUTY CLERK

**UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

Nancy M. Mayer-Whittington
Clerk of Court

**NOTICE OF RIGHT TO CONSENT TO TRIAL
BEFORE A UNITED STATES MAGISTRATE JUDGE**

The substantial criminal caseload in this Court and the requirements of the criminal Speedy Trial Act frequently result in the delay in the trial of civil cases. Aware of the hardship and expense to the parties, counsel, and witnesses caused by the delays which are beyond the control of the Court, this notice is to advise you of your right to trial of your case by a United States Magistrate Judge. By statute, 28 USC § 636(c), Fed.R.Civ.P. 73 and Local Civil Rule 73.1, the parties, by consent, can try their case by means of a jury trial or bench trial before a United States Magistrate Judge. Appeals from judgments and final orders are taken directly to the United States Court of Appeals for the District of Columbia Circuit, in the same manner as an appeal from a judgment of a District Judge in a civil case.

WHAT IS THE PROCEDURE?

One of the matters you are required to discuss at the meet-and-confer conference mandated by Local Civil Rule 16.3 is whether the case should be assigned to a United States Magistrate Judge for all purposes, including trial

All parties must consent before the case is assigned to a Magistrate Judge for trial. You may consent at any time prior to trial. If you expressly decline to consent or simply fail to consent early in the case, you are not foreclosed from consenting later in the case. However, a prompt election to proceed before a Magistrate Judge is encouraged because it will facilitate a more orderly scheduling of the case.

Counsel for the plaintiff has been furnished a copy of the "Consent to Proceed Before a United States Magistrate Judge for all Purposes" form. If and when the form is executed, your response should be made to the Clerk of the United States District Court only.

WHAT IS THE ADVANTAGE?

The case will be resolved sooner and less expensively. The earlier the parties consent to assigning the case to a Magistrate Judge the earlier a firm and certain trial date can be established, even if the case is to be tried to a jury.

Upon the filing of the consent form and with the approval of the District Judge, the case will be assigned to all purposes to a Magistrate Judge.

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA**

ELF ATOCHEM NORTH AMERICA, INC.
2000 Market Street
Philadelphia, PA 19103-3222

Plaintiff,

v.

Q. TODD DICKINSON,
Acting Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Defendant.

CASE NUMBER 1:99CV02559
JUDGE: Thomas Penfield Jackson
DECK TYPE: Civil General
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COMPLAINT

Plaintiff Elf Atochem North America, Inc., for its complaint herein, alleges as follows:

1. This civil action is brought to compel the Commissioner to issue a United States Letters Patent to plaintiff and arises under 35 U.S.C. § 145.

2. Plaintiff Elf Atochem North America, Inc. (hereinafter "Elf Atochem") is a corporation organized and existing under the laws of the state of Pennsylvania, with a principal place of business at 2000 Market Street, Philadelphia, Pennsylvania 19103-3222.

3. Defendant Q. Todd Dickinson is the Acting Commissioner of Patents and Trademarks, United States Patent and Trademark Office (hereinafter "PTO"), who in his official capacity as Acting Commissioner is a legal resident of the District of Columbia and within the jurisdiction of this Court. Commissioner Dickinson is hereby sued in his official capacity as Commissioner pursuant to 35 U.S.C. § 145.

4. Jurisdiction and venue are proper in this Court pursuant to 35 U.S.C. § 145 and, in the alternative, 28 U.S.C. §§ 1338 and 1391.

5. Elf Atochem is the assignee and owner of the entire right, title, and interest in and to United States Patent Application Serial No. 07/870,759 entitled "Improvement in the Stabilization of Vinyl Halide Polymers," filed April 20, 1992 (hereinafter "the '759 application"), by an assignment from the inventors Jean-Yves Chenard and Jean-Claude Mendelsohn.

6. Jean-Yves Chenard and Jean-Claude Mendelsohn are the first and original joint inventors of the invention disclosed and claimed in the '759 application.

7. The '759 application is a continuation of Application Serial No. 07/633,187, filed December 28, 1990 (abandoned), which is a continuation of Application Serial No. 07/273,669, filed November 18, 1988 (abandoned), which is a continuation of Application Serial No. 06/254,313, filed April 15, 1981 (abandoned), which is a continuation-in-part of Application Serial No. 06/070,503, filed August 28, 1979 (abandoned), and is entitled to the benefit of the filing dates of each of these applications under 35 U.S.C. § 120. The '759 application is also entitled to the benefit of the filing dates of French Application Nos. 7912005, filed May 11, 1979, and 7824863, filed August 29, 1978, under 35 U.S.C. § 119.

8. The '759 application was filed in accordance with the laws of the United States and the rules of the PTO, and was duly prosecuted before the tribunals of the PTO and in accordance with the laws of the United States and the rules of the PTO.

9. All of the pending claims of the '759 application were finally rejected by the Examiner in charge of the application at the PTO, namely claims 176-183, 193-198, 200-207, 209-217, 219-225, 227-233, and 237-323.

10. On December 13, 1993, the plaintiff appealed the final rejection to the Board of Patent Appeals and Interferences (hereinafter "Board"). On February 12, 1999, plaintiff was granted an oral hearing before the Board. On February 23, 1999, more than five years after an appeal was taken, the Board rendered its decision.

11. The Board affirmed-in-part and reversed-in-part the final rejections of the Examiner. More specifically, the Board affirmed the Examiner's rejection under 35 U.S.C. § 103, holding that claims 176-183, 193-198, 200-207, 209-217, 219-225, 227-233, and 237-323 were obvious in view of a combination of prior art references, including Gough, Stapfer, Hechenbleikner, Wowk, Schroeder, Weinberg and Kauder. The Board held among other things that: (a) the prior art rendered the claims prima facie obvious; and (b) the applicants' declaration evidence, submitted in support of patentability, did not rebut the prima facie case.

12. On April 22, 1999, plaintiff filed a Request for Rehearing Pursuant to 37 C.F.R. § 1.197(b), seeking to have the Board reverse its holding affirming the Examiner. On July 27, 1999, the Board denied plaintiff's request.

13. The decisions and holdings set forth in paragraphs 11 and 12, with which plaintiff Elf Atochem is dissatisfied within the meaning of 35 U.S.C. § 145, constitute clear error or, in the alternative, an abuse of discretion and are contrary to law. The Board erred in failing to reverse the Examiner on all grounds and failing to find all claims allowable.

14. In addition, plaintiff is foreclosed from filing a new application to introduce additional evidence in support of patentability or to rebut the § 103 rejection because any patent issuing on such application would expire before it issues. The patent laws were changed after June 8, 1995, under the GATT/TRIPs agreements, so that the patent term for any patent issued on

an application filed after June 8, 1995 was twenty (20) years from its earliest U.S. filing date, as opposed to seventeen (17) years from issuance under the old patent law. The earliest filed U.S. application listed in paragraph 7 was filed on August 28, 1979. Thus, if plaintiff attempted to file a new application now, any patent with a twenty (20) year term to issue from this application would have expired August 28, 1999, almost one month ago.

15. Although plaintiff appealed the Examiner's final rejection on December 13, 1993, a final decision by the Board was not forthcoming until February 23, 1999, long after the June 8, 1995 GATT/TRIPs date. The five year delay between the filing of an appeal and the Board's decision prevented the plaintiff from having an opportunity to refile the '759 application in the PTO in an effort to overcome the rejection under 35 U.S.C. § 103.

16. Thus, plaintiff Elf Atochem brings this action to reverse the final decision of the Board affirming the Examiner, and seeks a de novo determination of the question of obviousness, including but not limited to the decisions and holdings set forth in paragraphs 11 and 12.

17. Plaintiff Elf Atochem has filed this Complaint before expiration of the two-month period after the Board's decision on plaintiff's request for reconsideration. See 37 C.F.R. § 1.304(a)(1).

18. No appeal has been taken by Elf Atochem to the United States Court of Appeals for the Federal Circuit from the Board's February 23, 1999 or July 27, 1999 decisions.

WHEREFORE, plaintiff Elf Atochem prays for entry of judgment:

A. reversing the Board's affirmance of the Examiner's final § 103 rejection of claims 176-183, 193-198, 200-207, 209-217, 219-225, 227-233, and 237-323;

B. declaring that Elf Atochem is entitled to receive a United States Letters Patent for the invention defined by claims 176-183, 193-198, 200-207, 209-217, 219-225, 227-233, and 237-323;

C. directing the Commissioner to issue a United States Letters Patent containing claims 176-183, 193-198, 200-207, 209-217, 219-225, 227-233, and 237-323; and

D. granting such other and further relief as the Court shall deem just and proper.

ELF ATOCHEM NORTH AMERICA, INC.



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D.C. Bar No. 382759

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UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA

ELF ATOCHEM NORTH AMERICA, INC.,
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CERTIFICATE RULE LCvR 26.1


I, the undersigned, counsel of record for ELF ATOCHEM NORTH AMERICA, INC., certify that to the best of my knowledge and belief, the following are parent companies, subsidiaries or affiliates of Elf Atochem North America, Inc., which have outstanding securities in the hands of the public.

1. TotalFina
2. Elf Aquitaine

These representations are made in order that judges of this court may determine the need for recusal.

Attorney of Record

September 27, 1999
Date


Signature

382,759
Bar Identification No.

Richard B. Racine
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